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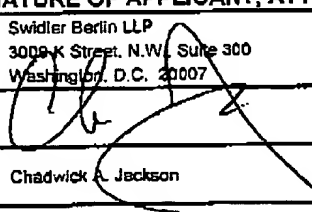
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/699,372	
	Filing Date	October 31, 2000	
	First Named Inventor	Courtney Hudson	
	Art Unit	3626	
	Examiner Name	Rachel L. Porter	
Total Number of Pages in This Submission	41	Attorney Docket Number	25737.0002

ENCLOSURES (check all that apply)		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:
Courtney HUDSON

Serial No.: 09/699,372

Art Unit: 3626

Filed: 10/31/2000

Examiner: PORTER, Rachel L.

Title: SYSTEM AND METHOD FOR
MATCHING PATIENTS WITH CLINICAL
TRIALS

NOTICE OF COPIED CLAIMS FROM PUBLICATION
AND REQUEST FOR INTERFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant by AMENDMENT AND REPLY filed concurrently herewith in response to the Office Action mailed November 2, 2004, for the above-captioned application, hereby provides NOTICE OF COPIED CLAIMS FROM PUBLICATION AND REQUEST FOR INTERFERENCE with U.S. Application Publication No. 2002/0002474 ("the Michelson publication"). The NOTICE OF COPIED CLAIMS FROM PUBLICATION AND REQUEST FOR INTERFERENCE seeks to have an Interference declared between the present application (the '372 application") and the Michelson publication. The Applicant submits that the Request for Interference should be approved since the requirements of 37 C.F.R. 1.604 have been satisfied, there is a difference of less than three months between the effective filing dates of the applications, and unusual circumstances exist that justifies approval of the Request for Interference by the Director of Technology Center 3600.

I. INTRODUCTION

The '372 application was filed on October 31, 2000 and is assigned to EmergingMed.com. The EmergingMed.com web site allows people with serious illnesses and their caregivers to compare a short personal profile to the enrollment criteria of thousands of clinical trials in a matter of minutes. The matching is performed in a secure environment that protects the confidentiality of both the person filling out the patient profile and the organization conducting the research. The list of clinical trials that match a patient profile is presented in an unbiased format. An application can be submitted to each of the clinical trials identified. The technology implemented by the EmergingMed.com web site is embodied in the '372 application. The claims of the '372 application currently stand rejected as anticipated by the Michelson publication.

The Michelson publication appears to be a continuation application from PCT/US01/02936 filed on January 29, 2001 and is assigned to Acurian, Inc. The PCT application claims priority to a provisional application filed on January 28, 2000. The PCT application contains additional disclosure that was not provided in the provisional application. The Michelson publication discloses similar subject matter as the '372 application. The claims of the Michelson publication currently stand rejected and Acurian has appealed the rejection of the claims to the Board of Appeal and Interferences.

The Applicant of the '372 application seeks to provoke an interference between the '372 application and the Michelson publication. To provoke the Interference in accordance with 37 C.F.R. § 1.604, new claim 39 has been presented in the AMENDMENT AND REPLY to the outstanding Office Action of the '372 application filed concurrently herewith, which is a copy of claim 138 currently pending in the Michelson publication, added claim 39 has been identified as corresponding to the proposed count of the Interference, and an explanation has been provided as to why an Interference should be declared. The applicant has also proven that the effective filing dates between the '372 application and the Michelson publication is less than three months and that unusual circumstances justifies the declaration of the Interference as required by MPEP § 2303. Since the Applicant has satisfied the requirements of 37 C.F.R. § 1.604 and MPEP § 2303 the Request for Interference should be granted.

The Applicant has presented a claim copied from currently pending US Application Publication No. 2002/0002474 ("the Michelson publication"). As a result, the above captioned application ("the '372 application") and the Michelson publication now disclose and claim the same patentable invention.

II. THE APPLICABLE LAW

1. Interference

Where two or more applications are found to be claiming the same patentable invention, they may be put in interference, dependent on the status of the respective applications and the difference between their filing dates. While normally one of the applications should be in condition for allowance, unusual circumstances may justify an exception to this if the approval of the TC Director is obtained. See MPEP § 2303. See also 37 CFR § 1.604.

An Interference will not be declared between pending applications if there is a difference of more than 3 months in the effective filing dates of the oldest and the next oldest applications, in the case of inventions of a simple character, or a difference of more than 6 months in the effective filing dates of the applications in other cases, except in exceptional situations, as determined and approved by the TC Director. See MPEP § 2303.

2. Effective Filing Date

The effective filing date of a U.S. application that is a continuation or divisional of one or more earlier U.S. applications or international applications, when the requirements of 35 U.S.C. §§ 120 and 365(c), respectively, have been satisfied, is the same as the earliest filing date in the line of continuation or divisional applications. See MPEP § 706.02.

If a U.S. application properly claims benefit under 35 U.S.C. § 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application. See MPEP § 706.02.

III. AN INTERFERENCE SHOULD BE DECLARED

1. Proposed Count of Interference

Applicant hereby proposes the following as Proposed Count 1 of an Interference declared between the '372 application and the Michelson publication:

Proposed Count 1: A method comprising the steps of:

(a) presenting at least one web page to permit an individual to be registered with a database by submitting information indicating whether notice of one or more clinical studies is desired and registration information, wherein the registration information includes at least a geographic location, a disease condition of interest, and contact information;

(b) automatically registering the individual with the database upon receipt of the registration and indicating information;

(c) automatically determining, in accordance with the indicating information and the registration information, whether to provide notice of a clinical study related to said disease condition;

(d) providing notice of said clinical study;

(e) presenting a screening questionnaire associated with said clinical study; and

(f) storing in the database answers submitted in response to said questionnaire.

Proposed count 1 corresponds to new claim 39 added to the '372 application.

2. Added Claim 39 is Supported by the Disclosure of the '372 application

The Applicant has added new claim 39 to the '372 application. 35 U.S.C. § 135(b)(2) bars a claim in another application that is substantially the same invention as is claimed in an application published under 35 U.S.C. § 122(b) if no such claim was presented prior to one year after the date of publication of the application. In the present case, the new claim 39 presented in the AMENDMENT AND REPLY is presented more than one year after the date of publication of the Michelson publication. However, the new claim 39 presented in the AMENDMENT AND REPLY is not barred by 35 U.S.C. § 135(b)(2) since the above

captioned application was filed prior to November 29, 2000, when 35 U.S.C. 135(b)(2) became prospectively effective. See § 4508 of Pub. L. 106-113.

The following table sets forth the relationship between added claim 39 presented in the '372 application, the Michelson publication, and the proposed count.

<u>'372 application</u>	<u>Michelson publication</u>	<u>Proposed count</u>
39	138	1

Claim 39 of the '372 application is the same as claim 138 of the Michelson publication and corresponds to Proposed count 1 of the requested Interference. The following table identifies where detailed support for newly added claim 39 can be found in the disclosure of the '372 application.

CLAIM

39. A method for recruiting an individual to participate as a subject in a clinical study, comprising the steps of:

(a) presenting at least one web page to permit an individual to be registered with a database by submitting information indicating whether notice of one or more clinical studies is desired and registration information, wherein the registration information includes at least a geographic location, a disease condition of interest, and contact information;

SPECIFICATION SUPPORT

This application discloses a method that allows patients to be recruited for clinical trials. See Specification, pg. 5, lines 4-7.

This application discloses that the method is implemented at a web site. Id. This application discloses that a user who is interested in searching for available clinical trials can select links directing the user to a clinical trial search process where the user can register with the web site and create a patient profile. See Specification, pg. 9, line 23-pg. 10, line 7. The information in the a user's registration record includes contact information (See Specification, pg. 8, line 16; pg. 16, line

CLAIM

(b) automatically registering the individual with the database upon receipt of the registration and indicating information;

(c) after step (b), automatically determining, in accordance with the indicating information and the registration information, whether to provide the individual or caregiver with notice of a clinical study associated with said disease condition;

(d) providing the individual notice of said clinical study;

SPECIFICATION SUPPORT

23) and a link to the patient's profile, which includes geographic location (See Specification, pg. 2 lines 25-26) and name of disease (See Specification, pg. 10, line 11).

When the user registers, the information is automatically stored in the user's registration record. See Specification, pg. 9, line 18-22. The user is also assigned a user ID number. Id. This user ID number is attached to the user's patient profile. Id.

This application discloses that after the patient profile is created a computer program process can automatically determine whether the patient prequalifies for a clinical trial associated with the named disease. See Specification, pg. 12, line 27, pg. 14, line 21. The determination is based on the user's selection of the clinical trial search process and the patient profile. See Specification, pg. 12, lines 15-20.

This application discloses that the user can be informed that they qualify for clinical trials. See

CLAIM

(e) presenting a screening questionnaire associated with said clinical study; and

(f) storing answers submitted by the individual in the database.

SPECIFICATION SUPPORT

Specification, pg. 15, lines 11-12 and 20-21.

This application discloses that after a preliminary determination of whether the patient prequalifies for any clinical trials, targeted questions specific to each clinical trial for which the patient has preliminarily qualified are provided. See Specification, pg. 15, lines 11-12.

The patient is allowed to submit an application for each trial site for which he or she qualifies. See Specification, pg. 15, lines 13-25.

The patient's applications and medical profile are submitted online to EmergingMed.com server where they are stored in a database. Specification, pg. 15, lines 13-25.

As demonstrated by the table above, the '372 application provides support for the newly added claim 39.

3. The Difference in the Effective Filing Dates of the Applications is Less than Three Months

The Applicant filed the '372 application on October 31, 2000 and, thus the effective filing date of the '372 application is October 31, 2000. The Michelson publication appears to be a continuation application from PCT/US01/02936 filed on January 29, 2001. See Exhibit A

– bibliographic page of Michelson publication. The PCT application claims priority to a provisional application filed on January 28, 2000. See Exhibit B – bibliographic page of PCT application. Based on the provisional filing date of the Michelson publication application, the difference between the effective filing dates of the Michelson application and the present application is more than 3 months. However, only claims of the Michelson publication that are fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application are entitled to the January 28, 2000 filing date. See MPEP § 706.02.

As indicated above, pending claim 138 of the Michelson publication has been presented as new claim 39 in the '372 application. Elements of claim 138 include, inter alia, “presenting at least one web page to permit an individual to be registered with a database by submitting information indicating whether notice of one or more clinical studies is desired ... and a disease condition of interest,” “automatically determining, in accordance with the indicating information and the registration information, whether to provide notice of a clinical study related to said disease condition,” “presenting a screening questionnaire associated with said clinical study,” and “storing in the database answers submitted in response to said questionnaire.” See Exhibit C – appendix to Appellants’ Brief showing claims on appeal. These elements of claim 138 are not fully supported under the first paragraph of 35 U.S.C. 112 by the disclosure embodied in the provisional application, and thus, claim 138 of the Michelson publication application is not entitled to the benefit of its provisional application’s January 28, 2000 filing date.. See Exhibit D – provisional application as filed.

Additional disclosure was added to the PCT application, which is not present in the provisional application. For example, the provisional application includes 10 pages of written description and 3 figures, while the PCT application includes 106 pages of written description and 114 pages of figures. This additional disclosure appears to support the elements recited in claim 138. Accordingly, the effective filing date for claim 138 is January 29, 2001, the filing date of the PCT application. Thus, the three month requirement is satisfied.

4. Status of the Applications

Copied claim 138 has not been allowed in either the Michelson publication or the '372 application. However, unusual circumstances justifies approval of this Request for Interference by the Director Technology Center 3600 despite the fact that there are no allowed claims in either application per authority of MPEP § 2303.

The assignee of the Michelson publication ("Acurian") and the assignee of the '372 application (EmergingMed.com) are direct competitors. Acurian has notified EmergingMed.com of the existence of the PCT application, to which the Michelson publication claims priority, and that one or more claims of PCT application is relevant to services provided by the EmergingMed.com web site. This suggests that there is a real threat of litigation between the parties should any claim of the Michelson publication become allowable. Accordingly, a patent should not be allowed to issue until an Interference is conducted.

While none of the claims in the Michelson publication are currently in condition for allowance, the Michelson publication is currently at the Board of Appeals ("Board") and could potentially be allowed by the Board. Likewise, while the Examiner has not yet deemed the claims in the '372 application to be in condition for allowance, it is believed that all of the Examiner's rejections are overcome by the AMENDMENT AND REPLY filed concurrently herewith, and that therefore, all of the claims of the '372 application are now in condition for allowance.

In view of the foregoing, it is believed that the Applicant's Request for Interference satisfies all the requirements of 37 CFR § 1.604 and respectfully requests approval of the request for Interference by the Director of Technology Center 3600 under the authority of MPEP § 2303.

Attorney Docket No. 25737.0002

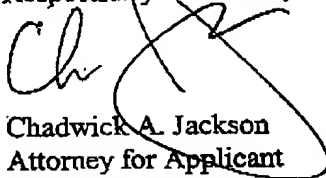
U.S. Serial No. 09/699,372

Courtney HUDSON

IV. CONCLUSION

In view of the above a declaration of interference is respectfully requested.

Respectfully submitted,


Chadwick A. Jackson
Attorney for Applicant
Reg. No.: 46,495

Date: July 19, 2005